

ESTTA Tracking number: **ESTTA381295**

Filing date: **12/01/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|----------------------|---|-------------|-----------|
| Name | Cemstone Products Company | | |
| Entity | Corporation | Citizenship | Minnesota |
| Address | 2020 Centre Pointe Boulevard Mendota Heights, MN 55120 UNITED STATES | | |
| Attorney information | Donald W. Niles Niles Law Office, P.A. 121 Colfax Ave. SW Wadena, MN 56482 UNITED STATES dniles@nilolaw.com Phone:612-296-7788 | | |

Applicant Information

| | | | |
|--------------------------------|--|---------------------------------|------------|
| Application No | 76549602 | Publication date | 11/09/2010 |
| Opposition Filing Date | 12/01/2010 | Opposition Period Ends | 12/09/2010 |
| International Registration No. | NONE | International Registration Date | NONE |
| Applicant | Breton S.P.A. Via Garibaldi, 27 31030 Castello di Godego (Treviso), ITALY | | |

Goods/Services Affected by Opposition

Class 007.

All goods and services in the class are opposed, namely: EQUIPMENT, MACHINES AND NUMERICAL CONTROL MACHINE TOOLS FOR FORMING, SIZING, POLISHING AND SHAPING OF MATERIALS AND PARTS THEREFOR; TRANSPORT SYSTEMS COMPRISED OF CONVEYORS AND HANDLING EQUIPMENT FOR MOVING AND CARRYING PRODUCTS AND MATERIALS

Grounds for Opposition

| | |
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| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3410223 | Application Date | 07/23/2003 |
| Registration Date | 04/08/2008 | Foreign Priority Date | NONE |

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|---------------------|---|
| Word Mark | CEMSTONE |
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 037. First use: First Use: 1994/00/00 First Use In Commerce: 1994/00/00 Construction services, namely, pumping, pouring and placing ready-mix concrete |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3410224 | Application Date | 07/23/2003 |
| Registration Date | 04/08/2008 | Foreign Priority Date | NONE |
| Word Mark | CEMSTONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 035. First use: First Use: 1996/04/00 First Use In Commerce: 1996/04/00 Retail store services featuring supplies and tools for use by concrete and mason contractors | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3410225 | Application Date | 07/23/2003 |
| Registration Date | 04/08/2008 | Foreign Priority Date | NONE |
| Word Mark | CEMSTONE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 019. First use: First Use: 1941/00/00 First Use In Commerce: 1941/00/00 Cementitious materials for commercial and residential applications, namely, ready-mix concrete, designed architectural concrete, concrete blocks, concrete blocks with a rock face; bulk quantities of sand, gravel, limestone and decorative landscape rock | | |

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| Related Proceedings | None |
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| Attachments | 2010-12-1 Cemstone Notice of Opposition re BRETONCEMSTONE.pdf (3 pages)(13093 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

| | |
|-----------|-------------------|
| Signature | /Donald W. Niles/ |
| Name | Donald W. Niles |
| Date | 12/01/2010 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|----------------------------|---|------------------------------|
| Cemstone Products Company, |) | |
| |) | |
| Opposer, |) | Opposition No.: _____ |
| |) | Application: S/N: 76-549,602 |
| vs. |) | Mark: BRETONCEMSTONE |
| |) | |
| Breton S.P.A., |) | Published: November 9, 2010 |
| |) | |
| Applicant. |) | |

NOTICE OF OPPOSITION

In the matter of pending Application Serial No. 76-549,602, filed October 6, 2003, by Breton S.P.A., for BRETONCEMSTONE in International Class 7 for “EQUIPMENT, MACHINES AND NUMERICAL CONTROL MACHINE TOOLS FOR FORMING, SIZING, POLISHING AND SHAPING OF MATERIALS AND PARTS THEREFOR; TRANSPORT SYSTEMS COMPRISED OF CONVEYORS AND HANDLING EQUIPMENT FOR MOVING AND CARRYING PRODUCTS AND MATERIALS,” published in the *Official Gazette* of November 9, 2010, Opposer Cemstone Products Company believes that it will be damaged, within the meaning of Section 13 of the Lanham Trademark Act, 15 U.S.C. § 1063, by the registration of the mark and hereby gives notice of its opposition to the above application.

The grounds for opposition are as follows:

1. Opposer Cemstone Products Company (“Opposer”) is a corporation duly organized and existing under the laws of the State of Minnesota, located and doing business at 2020 Centre Pointe Boulevard, Mendota Heights, Minnesota 55120.

2. Opposer is the owner of the valid and subsisting U.S. federal trademark registration No. 3410223 for the mark CEMSTONE, registered on April 8, 2008, for

“construction services, namely, pumping, pouring and placing ready-mix concrete” in International Class 037. Registration No. 3410223 was based upon an application filed in the U.S. Patent and Trademark Office on July 23, 2003, which is a date prior to the filing of Applicant’s application. Opposer’s first use in commerce of the CEMSTONE mark in connection with the services described in registration No. 3410223 was at least as early as 1994, which is a date prior to the filing of Applicant’s application.

3. Opposer is the owner of the valid and subsisting U.S. federal trademark registration No. 3410224 for the mark CEMSTONE, registered on April 8, 2008, for “retail store services featuring supplies and tools for use by concrete and mason contractors” in International Class 035. Registration No. 3410224 was based upon an application filed in the U.S. Patent and Trademark Office on July 23, 2003, which is a date prior to the filing of Applicant’s application. Opposer’s first use in commerce of the CEMSTONE mark in connection with the services described in registration No. 3410224 was at least as early as April 1996, which is a date prior to the filing of Applicant’s application.

4. Opposer is the owner of the valid and subsisting U.S. federal trademark registration No. 3410225 for the mark CEMSTONE, registered on April 8, 2008, for “cementitious materials for commercial and residential applications, namely, ready-mix concrete, designed architectural concrete, concrete blocks, concrete blocks with a rock face; bulk quantities of sand, gravel, limestone and decorative landscape rock” in International Class 019. Registration No. 3410225 was based upon an application filed in the U.S. Patent and Trademark Office on July 23, 2003, which is a date prior to the filing of Applicant’s application. Opposer’s first use in commerce of the CEMSTONE mark in connection with the services described in

registration No. 3410225 was at least as early as 1941, which is a date prior to the filing of Applicant's application.

5. Through its long, continuous and extensive use of its mark, the purchasing public has come to associate the mark CEMSTONE with Opposer and has come to recognize that the products and services marketed and sold under the mark CEMSTONE emanate from Opposer. Opposer's mark and registrations have priority over Applicant's application.

6. Applicant Breton S.P.A. is in no way associated with Opposer, nor has Opposer licensed or otherwise approved Applicant's use of, or application to register, the mark BRETONCEMSTONE.

7. In view of the similarity of the respective marks and the related nature of the respective parties' goods and services, Applicant's mark BRETONCEMSTONE so resembles Opposer's mark CEMSTONE, previously used in the United States and not abandoned, as to be likely to cause confusion, or cause mistake or to deceive.

8. Opposer believes that it would be materially damaged if Applicant's mark were registered, and therefore prays that registration of Applicant's mark BRETONCEMSTONE be refused and that this Opposition be sustained.

Respectfully submitted,

Niles Law Office, P.A.

Dated: December 1, 2010

s/Donald W. Niles
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**Attorney for Opposer
Cemstone Products Company**